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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,749	10/22/2001	Noboru Asauchi	Q66728	8429
7590 07/19/2006			EXAMINER	
SUGHRUE MION, PLLC 2100 Pennsylvania Avenue, NW Washington, DC 20037-3213			WU, RUTAO	
			ART UNIT	PAPER NUMBER
			3639	
DATE MAILED: 07/19/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/982,749	ASAUCHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rutao Wu	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 3-8, 12-17 and 21-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 and 33 is/are allowed.
- 6) ☒ Claim(s) 3-8, 12-17, 21-28 and 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. In response filed February 09, 2006 regarding Requirement for Restriction/Election the applicant's arguments are found to be persuasive. Therefore, the Restriction/Election requirement of claims 1-33 have been withdrawn.

### ***Status of Claims***

2. The Preliminary Amendment filed on March 23, 2006 has been entered. The applicants amended claims 3, 5, 6, 12, 14, 15, 21 and cancelled claims 1, 2, 9-11, 18-20. Claims 3-8, 12-17, 21-33 are pending in the application.

### ***Response to Arguments***

3. Applicant's arguments filed June 29, 2005 with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 3-5, 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat No. 6,798,997 to Hayward et al.

**Referring to claim 3:**

A method for determining a price at which a new expendable is to be supplied, the price being determined by a computer in response to a user inquiry, the method comprising the steps of:

(a) receiving the inquiry including expendable-related information by the computer, the expendable-related information being indicative of a model of an expendable container possessed by the user; and (col 7: lines 60-65)

(b) Hayward discloses that users see an order screen and choose methods of payment etc... (col 7: line 63-col 8: line 3) however, Hayward does not expressly disclose determining the price by the computer based on the expendable-related information,

The Examiner asserts that it is inherent that the price of the expendable is determined otherwise users would not be entering their payment information for purchasing of the expendable.

the expendable-related information includes information indicative of a remaining amount of expendable remaining in the expendable container. (col 9: lines 21-30)

**Referring to claim 4:**

The method in accordance with claim 3 wherein the expendable-related information includes information indicative of a type of expendable remaining in the expendable container. (col 8: lines 26-30)

**Referring to claim 5:**

A method for determining a price at which a new expendable is to be supplied, the price being determined by a computer in response to a user inquiry, the method comprising the steps of:

(a) receiving the inquiry including expendable-related information by the computer, the expendable-related information being indicative of a model of an expendable container possessed by the user; and (col 7: lines 60-65)

(b) Hayward discloses that users see a order screen and choose methods of payment etc... (col 7: line 63-col 8: line 3) however, Hayward does not expressly disclose determining the price by the computer based on the expendable-related information,

The Examiner asserts that it is inherent that the price of the expendable is determined otherwise users would not be entering their payment information for purchasing of the expendable.

the expendable container possessed by the user comprises a memory for storing the expendable-related information, and (col 4: lines 35-40)

the expendable-related information is to be read out from the memory. (col 7: line 58, 65)

**Referring to claim 12:**

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An expendable supply device for supplying a new expendable in response to a user request, the device comprising:

Hayward discloses that users see an order screen and choose methods of payment etc... (col 7: line 63-col 8: line 3) however, Hayward does not expressly disclose determining the price by the computer based on the expendable-related information,

The Examiner asserts that it is inherent that the price of the expendable is determined otherwise users would not be entering their payment information for purchasing of the expendable.

An expendable container mount configured to mount an expendable container possessed by the user; (col 8: lines 26-29)

A request receiver configured to receive the user request; and (col 8: lines 46-48)

An expendable supplier configured to supply the new expendable in response to the request; (col 8: lines 46-53)

Wherein the price determiner is further capable of:

Receiving the inquiry including expendable-related information indicative of a model of the expendable container mounted on the expendable container mount; and (col 7: lines 60-65)

Determining the price based on the expendable-related information, (col 7: lines 65-66)

Wherein

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The expendable-related information includes information indicative of a remaining amount of expendable remaining in the expendable container. (col 8: lines 26-29)

**Referring to claim 13:**

The device in accordance with claim 12 wherein

The expendable-related information includes information indicative of a type of expendable remaining in the expendable container. (col 8: lines 26-30)

**Referring to claim 14:**

An expendable supply device for supplying a new expendable in response to a user request, the device comprising:

Hayward discloses that users see an order screen and choose methods of payment etc... (col 7: line 63-col 8: line 3) however, Hayward does not expressly disclose determining the price by the computer based on the expendable-related information,

The Examiner asserts that it is inherent that the price of the expendable is determined otherwise users would not be entering their payment information for purchasing of the expendable.

An expendable container mount configured to mount an expendable container possessed by the user; (col 8: lines 26-29)

A request receiver configured to receive the user request; and (col 8: lines 46-48)

An expendable supplier configured to supply the new expendable in response to the request; (col 8: lines 46-53)

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Wherein the price determiner is further capable of:

Receiving the inquiry including expendable-related information indicative of a model of the expendable container mounted on the expendable container mount; and  
(col 7: lines 60-65)

Determining the price based on the expendable-related information (col 7: lines 65-66)

Wherein

The expendable container possessed by the user comprises a memory for storing the expendable-related information, and (col 4: lines 35-40)

The expendable-related information is to be read out from the memory of the device. (col 7: line 58, 65)

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-8, 15-17, 21-28, 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat No. 6,798,997 to Hayward et al in view of U.S. Pat No. 5,657,678 to Cohen.

**Referring to claim 6:**



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A method for determining a price at which a new expendable is to be supplied, the price being determined by a computer in response to a user inquiry, the method comprising the steps of:

(a) receiving the inquiry including expendable-related information by the computer, the expendable-related information being indicative of a model of an expendable container possessed by the user; and (col 7: lines 60-65)

(b) Hayward discloses that users see a order screen and choose methods of payment etc... (col 7: line 63-col 8: line 3) however, Hayward does not expressly disclose determining the price by the computer based on the expendable-related information,

The Examiner asserts that it is inherent that the price of the expendable is determined otherwise users would not be entering their payment information for purchasing of the expendable.

Wherein

Hayward does not expressly disclose providing the price based on user returning the expendable container.

Cohen discloses that a recycled cartridge may cost only one half or less the price of a new cartridge and the used cartridge must be sent out to another facility, or back to the manufacture, for recycling. (col 1: lines 45-46)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hayward's invention to provide a discount to

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the users returning the used cartridge. Cohen provides the motivation of reducing cost and wastefulness. (col 1: line 31)

**Referring to claim 7:**

Hayward discloses providing prices for ink cartridges. Hayward does not expressly disclose providing a first price based on the user returning the used cartridge to the supplier and a second price based on the user not returning the used cartridge based on the supplier.

Cohen discloses a price difference between a cartridge with recycling and a cartridge without recycling. (col 1: line 44)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Hayward to offer ink cartridges at a first and second price based on whether the user is returning the used cartridge. Cohen provides the motivation of reducing cost and wastefulness. (col 1: line 31)

**Referring to claim 8:**

Hayward does not expressly disclose providing the user with options of the first type price and the second type price.

Cohen discloses a first type price and a second type price. (col 1: line 44)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Hayward to offer ink cartridges at a first and second price based on whether the user is returning the used cartridge. Cohen provides the motivation of reducing cost and wastefulness. (col 1: line 31)

**Referring to claim 15:**

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An expendable supply device for supplying a new expendable in response to a user request, the device comprising:

Hayward discloses that users see an order screen and choose methods of payment etc... (col 7: line 63-col 8: line 3) however, Hayward does not expressly disclose determining the price by the computer based on the expendable-related information,

The Examiner asserts that it is inherent that the price of the expendable is determined otherwise users would not be entering their payment information for purchasing of the expendable.

An expendable container mount configured to mount an expendable container possessed by the user; (col 8: lines 26-29)

A request receiver configured to receive the user request; and (col 8: lines 46-48)

An expendable supplier configured to supply the new expendable in response to the request; (col 8: lines 46-53)

Wherein the price determiner is further capable of:

Receiving the inquiry including expendable-related information indicative of a model of the expendable container mounted on the expendable container mount; and (col 7: lines 60-65)

Determining the price based on the expendable-related information (col 7: lines 65-66)

Wherein

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Hayward does not expressly disclose providing the price based on user returning the expendable container.

Cohen discloses that a recycled cartridge may cost only one half or less the price of a new cartridge and the used cartridge must be sent out to another facility, or back to the manufacture, for recycling. (col 1: lines 45-46)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hayward's invention to provide a discount to the users returning the used cartridge. Cohen provides the motivation of reducing cost and wastefulness. (col 1: line 31)

**Referring to claim 16:**

Hayward discloses providing prices for ink cartridges. Hayward does not expressly disclose providing a first price based on the user returning the used cartridge to the supplier and a second price based on the user not returning the used cartridge based on the supplier.

Cohen discloses a price difference between a cartridge with recycling and a cartridge without recycling. (col 1: line 44)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Hayward to offer ink cartridges at a first and second price based on whether the user is returning the used cartridge. Cohen provides the motivation of reducing cost and wastefulness. (col 1: line 31)

**Referring to claim 17:**

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Hayward does not expressly disclose providing the user with options of the first type price and the second type price.

Cohen discloses a first type price and a second type price. (col 1: line 44)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Hayward to offer ink cartridges at a first and second price based on whether the user is returning the used cartridge. Cohen provides the motivation of reducing cost and wastefulness. (col 1: line 31)

**Referring to claim 21:**

A computer program product for causing a computer to determine a price at which a new expendable to be supplied in response to a user inquiry, the computer program product comprising:

A computer readable medium; and (col 4: lines 10-19)

A computer program stored on the computer readable medium, the computer program comprising:

A first program for causing the computer to receive the inquiry including expendable-related information by the computer, the expendable-related information being indicative of a model of an expendable container possessed by the user. (col 7: lines 60-65)

Hayward discloses that users see an order screen and choose methods of payment etc... (col 7: line 63-col 8: line 3) however, Hayward does not expressly disclose determining the price by the computer program based on the expendable-related information,

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The Examiner asserts that it is inherent that the price of the expendable is determined otherwise users would not be entering their payment information for purchasing of the expendable.

A third program for causing the computer to display the price to the user. (col 7: lines 63-65)

Wherein

Hayward discloses providing prices for ink cartridges. Hayward does not expressly disclose providing a first price based on the user returning the used cartridge to the supplier and a second price based on the user not returning the used cartridge based on the supplier.

Cohen discloses a price difference between a cartridge with recycling and a cartridge without recycling. (col 1: line 44)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Hayward to offer ink cartridges at a first and second price based on whether the user is returning the used cartridge. Cohen provides the motivation of reducing cost and wastefulness. (col 1: line 31)

**Referring to claim 22:**

Hayward does not expressly disclose providing the user with options of the first type price and the second type price.

Cohen discloses a first type price and a second type price. (col 1: line 44)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Hayward to offer ink cartridges at a first and second

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price based on whether the user is returning the used cartridge. Cohen provides the motivation of reducing cost and wastefulness. (col 1: line 31)

**Referring to claim 23:**

A method for supplying a new expendable by a computer, the new expendable being packaged in a new expendable container, the method comprising the steps of:

(a) accepting an inquiry regarding supply of the new expendable, the inquiry including expendable-related information indicative of a model of an expendable container possessed by a user. (col 7: lines 60-65)

(b) Hayward discloses providing prices for ink cartridges. Hayward does not expressly disclose providing a first price based on the user returning the used cartridge to the supplier

Cohen discloses a price difference between a cartridge with recycling and a cartridge without recycling. (col 1: line 44)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Hayward to offer ink cartridges at a first and second price based on whether the user is returning the used cartridge. Cohen provides the motivation of reducing cost and wastefulness. (col 1: line 31)

(c) displaying the first type price to the user; (col 7: lines 63-65)

(d) accepting a first type order from the user, the first type order generating a charge amount at the first type price on condition that the expendable container possessed by the user is returned; and (col 8: lines 46-48)

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(e) supplying the new expendable in exchange for the expendable container possessed by the user in response to the first type order. (col 9: lines 56-57)

**Referring to claim 24:**

Hayward discloses

The method in accordance with claim 23 wherein

The expendable container comprises a memory for storing the expendable-related information, and (col 4: lines 35-40)

The expendable-related information is to be read out from the memory. (col 7: line 58, 65)

**Referring to claim 25:**

The method in accordance with claim 23 wherein

The step (b) includes the steps of:

Hayward discloses providing prices for ink cartridges. Hayward does not expressly disclose providing a second price based on the user not returning the used cartridge based on the supplier.

Cohen discloses a price difference between a cartridge with recycling and a cartridge without recycling. (col 1: line 44)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Hayward to offer ink cartridges at a first and second price based on whether the user is returning the used cartridge. Cohen provides the motivation of reducing cost and wastefulness. (col 1: line 31)



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The step (d) includes a step of accepting the first type order if the first price has been determined, while accepting the second type order if the second price has been determined, the second type order generating a charge amount at the second type price in response to the price determination; and (col 8: lines 46-48)

Step (e) includes a step of supplying the new expendable in response to the second order. (col 9: lines 56-57)

**Referring to claim 26:**

The method in accordance with claim 25 wherein

Hayward does not expressly disclose providing the user with options of the first type price and the second type price.

Cohen discloses a first type price and a second type price. (col 1: line 44)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Hayward to offer ink cartridges at a first and second price based on whether the user is returning the used cartridge. Cohen provides the motivation of reducing cost and wastefulness. (col 1: line 31)

The step (d) further includes a step of accepting the first type order if the first price has been selected, while accepting the second type order if the second price has been selected, in response to a selection of the options. (col 8: lines 46-48)

**Referring to claim 27:**

The method in accordance with claim 23 wherein

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Hayward discloses the expendable-related information further includes information indicative of a remaining amount of expendable remaining in the expendable container. (col 8: lines 26-29)

**Referring to claim 28:**

The method in accordance with claim 27 wherein

Hayward discloses the step (c) further includes a step of displaying an expendable supply menu for supplying expendable if the remaining amount falls below a predetermined value. (col 7: lines 60-65)

**Referring to claim 30:**

A computer program product for causing a computer to accept an order for a new expendable, the new expendable being package in a new expendable container, the computer program product comprising:

A computer readable medium; and (col 4: lines 10-19)

A computer program stored on the computer readable medium, the computer program comprising:

A first program for causing the computer to accept an inquiry regarding supply of the new expendable, the inquiry including expendable-related information indicative of a model of an expendable container possessed by the user. (col 7: lines 60-65)

Hayward discloses that users see an order screen and choose methods of payment etc... (col 7: line 63-col 8: line 3) however, Hayward does not expressly disclose determining the price by the computer program based on the expendable-related information,

The Examiner asserts that it is inherent that the price of the expendable is determined otherwise users would not be entering their payment information for purchasing of the expendable.

A third program for causing the computer to control a display of the price to the user. (col 7: lines 63-65) and

A forth program for causing the computer to accept the order from the user; (col 8: lines 58-60)

Wherein

Hayward discloses providing prices for ink cartridges. Hayward does not expressly disclose providing a price based on the user returning the used cartridge to the supplier.

Cohen discloses a price difference between a cartridge with recycling and a cartridge without recycling. (col 1: line 44)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Hayward to offer ink cartridges at a first and second price based on whether the user is returning the used cartridge. Cohen provides the motivation of reducing cost and wastefulness. (col 1: line 31)

**Referring to claim 31:**

Hayward discloses

The computer program product in accordance with claim 30 wherein

The expendable-related information further includes information indicative of a remaining amount of expendable remaining in the expendable container. (col 8: lines 26-29)

**Referring to claim 32:**

Hayward discloses

The computer program product in accordance with claim 31 wherein

The third program further comprises a program for causing the computer to display an expendable supply menu for supplying expendable is the remaining amount falls below a predetermined value. (col 7: lines 58-65)

***Allowable Subject Matter***

8. Claims 29 and 33 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of

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the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat No. 7,013,092 to Hayward et al.

U.S. Pat No. 6,985,877 to Hayward et al.

U.S. Pat No. 5,170,710 to Harpold et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rutao Wu whose telephone number is (571)272-3136.

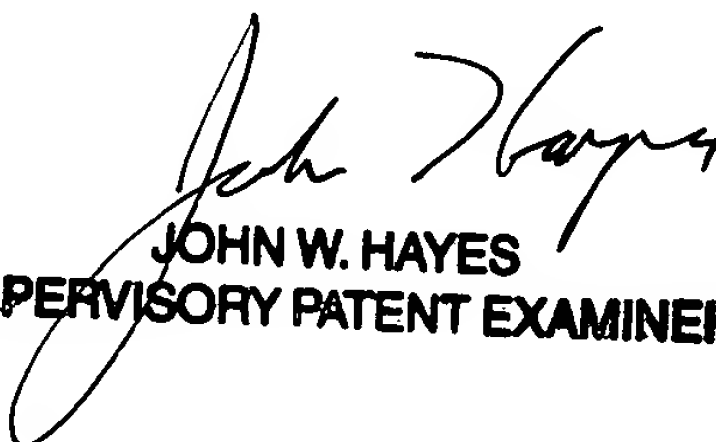
The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rw

  
**JOHN W. HAYES**  
**SUPERVISORY PATENT EXAMINER**